

REMARKS

Applicant by this response requests that prosecution be reopened pursuant to 37 C.F.R. § 41.50(b). Claims 30-49 are pending in the present application. The Examiner's rejection of the claims has been reversed on appeal. Claims 30 -39 are allowable and claims 40-49 have been rejected on new grounds by the Board. Claims 40-49 have been amended. Accordingly claims 30-49 remain pending in the present application.

The Board stated:

“ DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the rejection of claims 30-49.

We reverse the Examiner's rejections of these claims.

Rejections of claim 40 through 49 under 35 U.S.C. § 103(a).

Initially, we note that as discussed *infra*, we now reject claims 40 through 49 under 35 U.S.C. § 112 second paragraph as they are indefinite. Thus, the scope of the claims can not be determined. Our reviewing court has said that, it is wrong to rely upon speculative assumptions as to the meaning of claims and basing a rejection under prior art. *In re Steele* 305 F.2d 859, 862 (CCPA 1962). Thus, we will not sustain the Examiner's rejections of these claims under 35 U.S.C. § 103(a) as we will not speculate as to the scope of the claims and as such cannot determine whether the combination of the references teaches the claimed features.

NEW GROUNDS OF REJECTION UNDER 37 C.F.R. § 41.50(b)

Under 37 C.F.R. § 41.50(b), we enter a new ground of rejection under 35 U.S.C. § 112.

Independent claim 40 recites “A computer program product for monitoring quality of service ... comprising instructions for: encoding ... creating ... prior to play-out of the digital video program, the play-out device computing statistics ... including generating, ... comparing.” Thus, claim 40 clearly recites that there is one program product which performs the steps of encoding, creating, and transmitting the meta-stream. From Appellants' Specification it is apparent that these steps occur at one location, e.g., the program source item 10. However, it is unclear from claim 40 is either: a) the same program code also includes instructions directed to the play-out device which computes statistics (which according to Appellants' Specification are computed at a second location) (e.g. one disk which has program code to be used at both the transmitting location and the playout device location); or if b) the program code is merely performing the steps prior to the play-out device, and the claim omits some other mechanism which generates and compares the statistics associated with the play-out of the digital video

program. Appellants' Specification does not provide a detailed discussion as to what form or where the computer program product resides, which would guide the skilled artisan to ascertain the scope of this claim. Accordingly, we now reject claim 40 and the claims 41 through 49, which depend upon claim 40 under 35 U.S.C. § 112 as being indefinite.

ORDER

For the aforementioned reasons we will not sustain the Examiner's rejections of claims 30 through 49 under 35 U.S.C. § 103(a) and we enter a new rejection against claims 40 through 49 under 35 U.S.C. § 112.

The decision of the Examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner.

REVERSED

37 CFR § 41.50(b) "

ARGUMENTS

Rejection under 35USC § 112

Applicant has amended claim 40 to clearly recite a computer program product system that includes two computer readable mediums; a first medium for encoding; creating and transmitting the meta stream and a second medium located at the play out device for computing statistics. Claims 41-49 are amended solely to address antecedent basis issues. Accordingly, Applicant respectfully submits that claims 40-49 are now clear and definite and the rejection under 35USC 112 has been overcome.

CONCLUSION

Applicant submits that claims 30-39 are allowable. Furthermore applicant submits that the rejection of claims 40-49 have been overcome by the above identified amendments. Accordingly, Applicant respectfully requests reconsideration and allowance of claims 30-49 as now presented. Should any unresolved issues remain, the Examiner is invited to call the undersigned at the telephone number indicated below.

Respectfully submitted,
SAWYER LAW GROUP LLP

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Date

/Joseph A. Sawyer, Jr./
Joseph A. Sawyer, Jr.
Attorney for Applicant(s)
Reg. No. 30.801

Customer Number: 54891
Office: (650) 493-4540
Fax: (650) 493-4549